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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/540,401 03/31/00 BONEY

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EXAMINER

HARRIS, C

ART UNIT PAPER NUMBER

3713

DATE MAILED:

08/29/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/540,401

Applicant(s)

BONEY ET AL.

Examiner

Chanda L. Harris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. Drawings have been objected to as being informal. See Notice of Draftsperson Patent Drawing Review (Form PTO 948).

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 and 2 are provisionally rejected under the judicially created doctrine of double patenting over claims 18 and 30 of copending Application No. 09/364,047. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: receiving control

information at the device controller reflecting at least one instruction from the client computer regarding a task to be performed as part of the training exercise, performing an operation associated with at least one of the devices of the set of devices, and providing a result of the operation to the client computer. "Proxy" does not add any patentable weight to the claims as such would be considered an inherent and obvious feature of the claimed invention.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what is inferred by server/controller. Server and controller? Server or controller (one or the other but not both)? Or, server and at least one controller, etc.? Applicant is required to specifically define the subject matter being claimed pertaining to server/controller in the aforementioned claims.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. **Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by**

**Bullen (U.S. Patent No. 6,033,226).**

8. Bullen discloses [Claims1-2]:

-receiving control information at a proxy in the device controller reflecting at least one instruction from the client computer regarding a task to be performed as part of the training exercise:

-performing an operation associated with at least one of the devices of the set of devices:

-providing a result of the operation to the client computer:

The training system 2 trains the operator 4 to perform specific tasks in an environment 9 outside of the computer 6. For example, the training system 2 can teach the operator 4 to machine a part or workpiece 10 with a machine tool 11 by responding to inputs 12 by the operator 4. The input can be stored in the computer memory 7.

The training system 2 can also have, but does not have to have, interface software 14 interfaced to an actual machine tool 11 of an outside situation or environment 9 for direct response and control of the environment 9. The interface software 14 operates on the computer 6 for controlling the machine tool 11. The interface software 14 can share access to and exchange of data with the memory medium 7.

Also, the training system 2 can further include a remote station 16 linked to the computer memory 7 of the interactive computer 6. The remote station 16

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can have an instructor for monitoring and supervising the operator 4 in real time. Moreover, the remote station 16 can share access to and exchange data with the computer memory 7. The remote station 16 can be linked to the computer 6 in any suitable networking manner, such as via an intranet or internet connection. Col.3: 57 – 4: 11

A “proxy” would be an inherent feature in Bullen's invention.

9. Bullen discloses [Claims 3-4]:

-a server controller transferring overhead information ... :

-the device controller using the overhead information to exercise control over at least one of the devices ... :

The operator can select for which tooling operation he or she would like to be trained. Once a tooling operation has been selected, various functions become available to the operator/user with respect to that particular tooling operation. These can include for instance, an example of a tooling operation 80, practice of a tooling operation 81, simulation of a tooling operation 82, expert advice on a tooling operation 83, diagrams 84 of the machined part and tooling steps, a self-test 86 of a particular tooling function, a walkthrough of a particular tooling operation 85 and other functions 87 suitable to interactively train an operator 4.

The graphical user interface 24 includes screen objects to provide event driven functionality for the training software 8. The objects include menu control buttons, integrated windows or viewer areas and icons that allow the operator 4, such as a machine tool operator, to view and select various items as will be discussed more specifically with respect to the specific graphical user interface displays available within the software. Col.4: 53 – 5:4

### ***Conclusion***

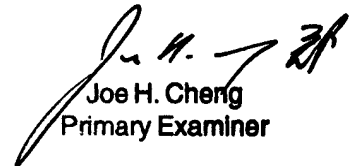
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanda L. Harris whose telephone number is 703-308-8358. The examiner can normally be reached on M-F 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Chanda L. Harris  
Examiner  
Art Unit 3713

*Ch.*  
ch.  
August 21, 2001

  
Joe H. Cheng  
Primary Examiner